

REMARKS

Claims 33-40 are pending. By this Amendment, claims 25-32 are cancelled without prejudice or disclaimer, and claims 33-37 are amended. No new matter is added.

Support for the amendment to claims 33 and 35 is found at least in paragraph [0022] of the Specification. Support for the amendment to claims 34, 36, and 37 is found at least in paragraph [0021] of the Specification.

It is respectfully submitted that entry of the amendments is proper as 1) the amendments are made to cancel claims, 2) the amendments will place the application in condition for allowance or at least present the claims in better form for appeal, and 3) there is good and sufficient reason why the amendments are necessary and were not earlier presented. As to the third point, it is respectfully submitted that the amendments will place the application in condition for allowance, and were not presented earlier to fully argue the patentability of the claims. The amendments should not raise new issues requiring more than nominal consideration by the Examiner.

For the following reasons, reconsideration is respectfully requested.

REJECTIONS UNDER 35 U.S.C. §101:

On page 3, item 3 of the Office Action, claims 25-34 are rejected under 35 U.S.C. §101, as being directed to non-statutory subject matter. The rejection as to cancelled claims 25-32 is moot. The rejection of claims 33 and 34 is respectfully traversed.

As a preliminary matter, 35 U.S.C. Sec. 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter. The latter three categories define "things" or "products" while the first category defines "actions" (i.e., inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) ("The term 'process' means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material."). Also, the subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena.

In this instance, claims 33 and 34 fit into one of the four statutory categories as a manufacture. Specifically, claims 33-34 are directed to an information storage medium (and therefore, a manufacture). Accordingly, the claimed invention is directed to statutory subject matter.

Moreover, the claimed manufacture is facially not abstract ideas, laws of nature, and natural phenomena that would be ineligible for a patent.

Additionally, regarding the assertion in the Office Action that claims 33 and 34 are directed to a computer program stored in a computer readable storage medium for implementing a method, and that "apparatus", "unit" as well as "storage medium" is not presented by the specification as anything more than a software program, Applicants respectfully note that even if claims 33 and 34 are as asserted by the Office Action, they would still be patentable as set forth in the Interim Guidelines for Examiner of Patent Application for Patent Subject Matter Eligibility, p. 52 and the Manual of Patent Examining Procedure §2106 (IV)(B)(1)(a), where claims were considered compliant with 35 U.S.C. §101 even though they were stored data structure that "defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized." (This test reflects the understanding of patentable data structures as set forth by the Federal Circuit in In re Lowry, 32 F3d 1579, 1584, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) that, "[m]ore than mere abstractions, the data structures are specific electrical or magnetic structural elements in a memory." As such, and as distinguished from compilations of music, functional relationships between the stored data elements which are realized by an apparatus define an invention within the meaning of 35 U.S.C. §101.)

Consistent with this definition of functional relationships, claim 33 recites, among other elements, "one or more interactive graphics streams which are used to control reproduction of audio-visual data and are reproduced with the audio-visual data, wherein one interactive graphics stream among the one or more interactive graphics streams is selected by attribute information in a player status register in the reproducing apparatus." As such, claim 33 recites substantive functional relationships between the stored elements.

Based on at least the above, it is respectfully submitted that claim 33 is compliant with 35 U.S.C. §101. Claim 34 is deemed compliant with 35 U.S.C. §101 for at least similar reasons.

REJECTION UNDER 35 U.S.C. §102:

On page 3, item 5 of the Office Action, claims 25-40 are rejected under 35 U.S.C. §102(b) as being anticipated by Nonomura et al. (U.S. Patent No. 6,118,445). The rejection of cancelled claims 25-32 is moot. As to claims 33-40, the rejection is respectfully traversed.

It is respectfully submitted that Nonomura fails to disclose or suggest, an information storage medium for use with a reproducing apparatus providing a visual display of interactive graphics, the information storage medium comprising one or more interactive graphics streams which are used to control reproduction of audio-visual data and are reproduced with the audio-visual data, wherein one interactive graphics stream among the one or more interactive graphics streams is selected by attribute information in a player status register in the reproducing apparatus, as recited in claim 33.

Also, it is respectfully submitted that Nonomura fails to disclose or suggest, an apparatus providing a visual display of interactive graphics by reproducing one interactive graphics stream among one or more interactive graphics streams from an information storage medium, the apparatus comprising a processor which obtains attribute information in a player status register in the apparatus, and a decoder which reads and reproduces one of the interactive graphics streams corresponding to the obtained attribute information from among the one or more interactive graphics streams from the information storage medium, the one interactive graphics stream being used to control reproduction of audio-visual data and being reproduced with the audio-visual data, as recited in claim 35.

That is, claims 33 and 35 call for one interactive graphics stream, attribute information, and a player status register and their recited interrelationship.

In Nonomura, instead of interactive graphic streams, the attribute information, or a player status register, as called for in claims 33 or 35, disclosed is an editing apparatus which edits system stream reproduction control information which controls reproduction order of a multimedia optical disc (see col. 1, lines 9-15 of Nonomura), and parameter strings, which conforms to the standard for multimedia optical discs and which is to be used for generating the outputted strings (see, Abstract, lines 6-10 of Nonomura).

That is, rather than disclosing one interactive graphic streams of the attribute information, Nonomura discloses an editing apparatus which edits system stream reproduction control information which controls reproduction order of a multimedia optical disc. Further, rather than

an attribute information in a player status register, Nonomura discloses parameter strings used to generate the outputted strings. Finally, Nonomura is silent as to the player status register.

Accordingly, the interactive graphic streams, the attribute information, and the player status register, as recited in claims 33 or 35 are not shown by the editing apparatus and the parameters of Nonomura. Thus, claims 33 and 35 are patentably distinguishable over the applied reference to Nonomura.

Claim 34, which depends from claim 33, and claims 36-40, which depend from claim 35, are likewise patentably distinguishable over the applied reference for at least the reasons discussed above, and for the additional features they recite. Withdrawal of the rejection is respectfully requested.

INTERVIEW:

The Examiner contacted the undersigned on December 21, 2007 and a short telephone interview was conducted wherein the Application was briefly discussed. The substance of the interview is incorporated into the remarks herein and the remarks constitute the Applicants' record of the interview.

Although the Examiner has characterized the claims, it is respectfully submitted that the claims are distinguishable over the applied reference for the reasons stated herein.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 2/26/2008

By: Seth S. Kim
Seth S. Kim
Registration No. 54,577

1400 Eye St., N.W.
Suite 300
Washington, D.C. 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9510